

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF WISCONSIN

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BETTER EDUCATION, INC.,

Plaintiff,

v.

RENAISSANCE LEARNING, INC.,

Defendant.

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OPINION AND ORDER

10-cv-286-wmc

The court is in receipt of defendant Renaissance Learning, Inc.'s motion to stay pending the outcome of the USPTO's *ex parte* reexamination of plaintiff Better Education, Inc.'s U.S. Patent No. 5,002,491 ("491 patent"). (Dkt. #16.) Typically, this court's practice is to deny such a stay request because (1) of the limited efficiencies gained through the reexamination proceedings and (2) the length of the stay tends to be immoderate. *See Grice Eng'g, Inc. v. JG Innovations, Inc.*, 691 F. Supp. 2d 915, 920 (W.D. Wis. 2010). ("A stay that is so extensive as to be 'immoderate' is an abuse of discretion."). Even Renaissance Learning acknowledges that the average length of a stay pending reexamination is more than two years (dkt. #16 at 7), which is well beyond the average time to trial in this court.

Nevertheless, Renaissance Learning represents that there is a substantial likelihood that some or all of the claims at issue will be found invalid, or at least that the claims will be amended, which is likely to moot or substantially impact the outcome of this case. Moreover, Better Education appears, in not opposing the motion, to be in agreement that some efficiencies may be gleaned by deferring to the USPTO. (Dkt. #18.) Finally, the

'491 patent expired on April 28, 2009, eliminating the possibility of injunctive relief, as well as ongoing damages.

Accordingly, the court will grant a stay, but only if Renaissance Learning stipulates that it will not raise in this case any prior-art reference considered by the USPTO during the *ex parte* reexamination. In that way, efficiencies will be realized regardless of how the USPTO rules. Otherwise, this matter will proceed on a typical track in this court.

### ORDER

IT IS ORDERED that:

- 1) Within ten days, defendant Renaissance Learning, Inc. shall either (a) file with the court a signed copy of the following stipulation, or (b) notify the court in writing of its decision not to sign the following stipulation.

In exchange for entry of a stay, Renaissance Learning will not challenge the validity of the patent in suit in this case based on any prior-art references that were considered in the reexamination.

- 2) The preliminary pretrial conference set for tomorrow, May 25, 2011, shall proceed as scheduled.

Entered this 24th day of May, 2011.

BY THE COURT:

/s/

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WILLIAM M. CONLEY  
District Judge